



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/977,915 11/25/97 VERNER P 1267/13

ADAMS LAW FIRM  
2180 FIRST UNION PLAZA  
CHARLOTTE NC 28282

QM12/0202

EXAMINER

FALIK, A

ART UNIT

PAPER NUMBER

3741

13

DATE MAILED:

02/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/977,915

Applicant(s)  
Verner et al

Examiner  
Andy Falik

Group Art Unit  
3741



☒ Responsive to communication(s) filed on Nov 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-19 is/are allowed.

☒ Claim(s) 20-23 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3741

## DETAILED ACTION

### *Recapture Rule*

Claims 20-23 are rejected for the reasons stated on pages 2 and 3 in the 8/9/99 Amendment (Paper #11) under the equitable "recapture" doctrine.

### *Applicant's Arguments*

Applicant's arguments on pages 1-5 in the 11/22/1999 Amendment have been considered but aren't deemed persuasive in overcoming this rejection since it is the examiner's position that the limitations "downwardly directed" and "towards the threads of the warp" are omitted limitations that were argued by applicant in the original application to make the claims allowable over a rejection. Specifically applicant argues these two limitations as distinguishing features over a plurality of art rejections during the prosecution history of the original application in the following locations: (1) the second paragraph on page 6 in the 2/7/95 Amendment; (2) the second paragraph on page 7 in the 8/17/94 Amendment; and (3) the third paragraph on page 8 in the 3/28/94 Amendment.

Applicant's assertion in the last paragraph on page 2 in the 11/22/99 Amendment that these limitations "were not critical to patentability of the original claims, but instead were limitations merely incidental to the distinguishing feature of the invention- *the displacement type flow*" is mitigated by the aforementioned multiple arguments as to the criticality of these two

Art Unit: 3741

features. The examiner is in agreement with Applicant that the displacement type flow is a critical limitation that distinguishes the original claims over the prior art but is in disagreement that the aforementioned two limitations were not critical, and that applicant abandoned claimed subject matter without those limitations. That the references applied in the rejection of the claims in the patent application could have been distinguished on different grounds than the applicant used to overcome the rejection is immaterial. The public has a right to rely on the assertions made by a patent applicant to secure allowability of its claims. After- the- fact argument cannot be used to reclaim abandoned subject matter, Desper v. Qsound, 48 USPQ2d 1088 (Fed. Cir. 1998).

Pursuant to applicant's remarks on the bottom of page 3 in the 11/22/99 Amendment the reason the Examiner stated that the only distinguishing feature from the prior art and the original claim 1 was the displacement type air flow is that the prior art already showed said downwardly directed and towards the warp limitations (see Fig. 20 in the "Report" reference).

It is for the above reasons that the omitted towards the warp and downwardly directed limitations relate to subject matter previously surrendered by applicant, and impermissible recapture exists.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 3741

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Caille

(3,744,724) where re claim 20, a staged conditioned air stream is disclosed in col.3 lines 37-41 in the reference to be applied across the entire width of a loom. Re claim 21, the recited spaced apart air distribution components are shown by the perforated wall members 1& 11, the turbulent spaces 6, and the baffles 7 in the reference Fig.1. Re claims 22 and 23, the first and second air distribution components are anticipated by the Fig.1 turbulent spaces 6 and 16, and the recited air inlet by the channel 1 in the reference Fig. 1.

### *Allowable Subject Matter*

Claims 1-19 are allowed over the art of record (including the aforementioned '724 reference) taken singly or in combination because of their recitation to a downwardly directed conditioned air stream onto warp threads or to a weaving machine in combination with a conditioned air stream means having an outlet located above the machine.

### *Conclusion*

---

Any inquiry to the merits of this office action or to any specific features of this communication or earlier communications from the examiner should be directed to Andy Falik whose telephone number is (703) 308-1283. The examiner can normally be reached on Monday-Thursday from 7:30AM-6:00PM.


Serial Number: 08/977,915

Page 5

Art Unit: 3741

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvert can be reached on (703) 305-1025. The fax phone number for this Group is (703) 305-3588.

Any inquiry of a general nature such as a missing reference or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861. Any inquiry relating to the drawings should be directed to the Drafting Branch whose telephone number is (703) 305-8404.



**ANDY FALIK  
PRIMARY EXAMINER  
GROUP 3741**

AMF  
January 27, 2000